

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: MARUTA=3C

In re Application of:	)	Art Unit: 1652
	)	
Kazuhiko MARUTA et al.	)	Examiner: R. PROUTY
	)	
Serial No.: 09/419,305	)	Washington, D.C.
	)	
Filed: October 15, 1999	)	July 13, 2001
	)	
For: RECOMBINANT THERMOSTABLE	)	
ENZYME WHICH...	)	

TERMINAL DISCLAIMER

Honorable Commissioner of Patents  
Washington, D.C. 20231

Sir:

KABUSHIKI KAISHA HAYASHIBARA SEIBUTSU KAGAKU KENKYUJO,  
a corporation of the Country of Japan, having a principal place  
of business at 2-3, 1-chome, Shimoishi, Okayama-shi, Okayama,  
Japan, (hereinafter referred to as "Assignee"), is the owner of  
100% of the entire right, title and interest in and to the above-  
identified application and any patent to be granted thereon.  
Assignee, through its undersigned agent of record, hereby  
disclaims the terminal part of any patent granted on the above-  
identified application which would extend beyond the expiration  
date of the full statutory term of United States Patent No.  
5,976,856, plus any extension thereof which may be subsequently  
granted, and hereby agrees that any patent so granted on the  
above-identified application shall be enforceable only for and

07/20/2001 DTHOMAS 00000002 09419305

01 FC:148

110.00 OP

during such period that said patent is commonly owned with United States Patent No. 5,976,856, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantor, its successors or assigns. Assignee does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term of United States Patent No. 5,976,856 in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321(1), has all claims cancelled by reexamination certificate, or is otherwise terminated prior to expiration of its full statutory term, except for the separation of legal title stated above. This terminal disclaimer is being made without waiver of petitioner's rights under 35 U.S.C. §156, or elsewhere, which may be available to extend the term of any patent granted on the above-identified application beyond the date set by this terminal disclaimer (37 C.F.R. §1.775(a)). The fee required by 37 C.F.R. §1.20(d) is attached hereto.

It is Assignee's intent that the amount of time disclaimed and the scope of the common ownership clause be the minimum required by law and this document is to be construed to effectuate said intent. No admission is made that any

**SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM**

DATE: 2-25-01

APPL. S.N.: 091 419,305

TO EXAMINER: R. Prouty

ART UNIT: 1652

**MOSE MONTGOMERY, ROOM 11E18**

MAILROOM DATE 7-13-01

AFTER FINAL YES ☒ NO ☐ NUMBER OF T.D(S). FILED 1

**INSTRUCTIONS:** I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ \_\_\_\_\_ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: \_\_\_\_\_

☐ Suggestion to request refund of \$ \_\_\_\_\_. (See 14.35, 14.36).

**☐ EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

**FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:**

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)